

REMARKS

Claims 1 – 2 and 4 – 7 are pending. Claim 3 has been canceled. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 2 – 7 were objected to for the informalities identified in the office action. Claim 2 has been canceled. It is respectfully submitted that the objection is moot.

Claim 5 was rejected under 35 USC 112, second paragraph, as being indefinite. Claim 5 has been amended. It is respectfully requested that the rejection be reconsidered and withdrawn.

Claims 1 – 7 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,148,894, Eddy (“Eddy”) in view of U.S. Patent No. 5,180,038, Arnold et al. (“Arnold”), further in view of JP 61236934, Oka (“Oka”). Features from claim 3 have been incorporated into amended claim 1. Insofar as the rejection can be applied to the claims as amended, the rejection is respectfully traversed for reasons including the following, which are provided by way of example.

Independent claim 1 recites in combination, for example, “an interconnecting portion provided on a shaft of the electric motor,” and that “a machine tool ... will be engaged with the interconnecting portion.”

Consequently, in operation, the torque of the electric motor required for applying the parking brake force to the wheels can be reduced. Moreover, the force required for manually rotating the parking braking device can be reduced, where the rotating force is applied by the machine tool (e.g., a wrench or screw driver) to the shaft of the electric motor.

It is apparent from Eddy that an extending end of the piston rod 30 is formed to receive a tool such as a socket, wrench or screwdriver. (E.g., Col. 3, lines 45 – 58.) This extending end corresponds to the interconnecting portion recited in claim 1 as amended. According to Eddy, a spur gear 68 is connected to an electric motor 66. Eddy neither teaches nor suggests that the extending end of the piston rod is provided on a shaft of the electric motor 66.

According to Arnold, a socket opening 36b is formed at a right hand end of a drive screw 36. A suitable wrench may be inserted for engagement with the socket opening 36b. (E.g., Col. 4, lines 35 – 52.) Arnold also discloses a direct current motor 50 having an output shaft 52. (E.g., Fig. 2.) As is apparent from Fig. 2, the socket opening 36b is not provided on the output shaft 52 of the motor 50.

Oka fails to remedy the deficiencies of Eddy and/or Arnold.

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima*

facie case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Where, as here, the examiner fails to establish a *prima facie* case of obviousness, the applicant has no burden to rebut the rejection of obviousness with evidence. In re Rijckaert, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The applicants have provided above a selection of some examples of limitations in the claims which are neither taught nor suggested by Eddy, Arnold and/or Oka, alone or in combination. For example, as recited in claim 1, the interconnecting portion is provided on the shaft of the electric motor. The speed reduction mechanism is provided between the electric motor and the main braking device.

For the reasons provided above, Eddy and Arnold and/or Oka, alone or in combination, fail to teach or suggest the combination of features recited in independent claim 1, when considered as a whole.

With respect to the rejected dependent claims, applicants respectfully submit that these claims are allowable not only by virtue of their dependency from independent claim 1, but also because of additional features they recite in combination.

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shown any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

The applicants respectfully request entry of the present amendment for the following reasons. First, the amendments to the claims are necessary to further clarify the claimed invention to the Examiner with respect to claiming the full scope of patent protection which the applicants believe is appropriate and/or to address claim informalities. These amendments address the Examiner's issues with respect to the claimed invention, and most were unable to be introduced earlier since additional rejections or references were included in the Final Office Action.

Second, the amendments to the claims do not raise new issues requiring further search since the amendments either involve incorporating features already existing in other pending claims and/or include a narrowed and/or broadened scope of protection that should not be burdensome for the Examiner to review.

Third, the applicants respectfully submit that no new matter has been introduced. In addition, the amendments made to the claims are minor changes performed in response to the Examiner's comments.

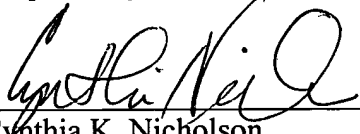
Fourth, the amendments to the claims place the application in better form for appeal by materially simplifying the issues, i.e., correcting formality requirements and clarifying the asserted patentable distinctions over the prior art.

Accordingly, the applicants respectfully request entry of the present Amendment.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Cynthia K. Nicholson', written over a horizontal line.

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